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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/298,889	04/26/1999	RAVI GANESAN	33500-030	2552

7590 03/10/2003

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EXAMINER

GORT, ELAINE L

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/298,889

Applicant(s)

GANESAN, RAVI

Examiner

Elaine Gort

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-8,12-14,17,18 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) 1,5,6,18,21,24,25 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7,8,12-14,17,22,23, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 1, 5, 6, 18, 21, 24, 25 and 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 19.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7, 8, 12, 13, 14, 17, 22, 23, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear in claim 7 lines 7 and 8, and claim 14 lines 9 and 10, what the difference is between the instruction to make payment and the instruction to transmit the directive to transfer funds. This appears redundant as the directive to transfer funds inherently includes the payment of a bill, and vice versa. Payment inherently includes a transfer of funds. It is unclear what additional limitation is being added by stating both.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 7, 8, 12, 13, 14, 17, 22, 23, 26 and 27 are rejected under 35

U.S.C. 102(e) as being anticipated by Chang et al. (US Patent 5,884,288).

Chang et al. discloses an electronic bill payment system and network having a  
Communications network (such as communication network shown in figure 2  
including the internet);

Network stations capable of transmitting instructions to pay bills and to view  
remittance information ( such as network stations shown as 202 and 208);

Wherein payers and payees have associated payment accounts and deposit  
accounts maintained at a plurality of financial institutions (206, see also column 5, lines  
10+);

A processor/central network station (such as shown in figure 2 including the  
Internet and 206) configured to receive instructions from payors to pay the bill by  
transmitting a directive to transfer funds and generate remittance information (such as  
an instruction 806 from 804 instructing to pay bill, figure 8B), to generate a directive to  
transfer funds (directive made after payment instruction (806) is entered by payor and  
payor's bank account is drawn on), to generate remittance information associated with  
payment of the first bill (remittance information includes Payee name, Due Date, and  
Amount Due which are generated by payee, see figure 8B, generated when payee  
accesses payor's account and creates bill, additionally remittance information includes

the amount paid which is generated at the time the bill is paid, further the amount owed would also be generated to know what is outstanding);

A central database configured to store the remittance information (such as the databases shown in figure 2 and other databases not shown but on the Internet, remittance information is stored with the bill at the payor's bank presumably in the bill payment database (250) and is also stored in the payee's accounting records disclosed in column 7, line 9+ and line 37+ which is accessible to the payee. These customer accounts are accessible via a payee network system with the customer/payor database accessible over the internet) so as to be accessible to a payee;

Network stations for transmitting payee request to access stored remittance information (such as 208);

Where the processor receives payee requests to access remittance information and transmits the requested information (occurs whenever payee accesses stored information, for example: when payee creates a bill, checks account status, updates account information or when a payment is made directly to payee); and

Where the processor generates the directive to transfer funds only after the receipt of the request to access remittance information (directives are commonly batched and may not have been generated until after the payee requests remittance information).

All other claimed limitations are disclosed or inherent.

See prior Office Actions for further details.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. In the alternative, claims 7, 8, 12, 13, 14, 17, 22, 23, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al.

Chang et al. discloses the claimed invention but is silent regarding the structure of the companies performing the billing, such as the number of user stations each payee has, how customer accounts are stored and accessed, and how they are configured. The use of internal network systems within a company which includes networked P.C.s and servers containing accounting data providing access to accounting and payment records on a company server via either an Intranet or the Internet is old and well known in the art of networking to allow multiple users with the ability to perform the same activities such as update accounting records. The use of more than one deposit account is old and well known in the art of accounting to track income relating to different internal businesses or operations carried out by the same company. An example of this is the tracking of income from services and income from products which generally require independent accounting due to differing tax implications along with the desire of companies to understand the differences in the two internal businesses. It would have been obvious to one having ordinary skill in the art at the time the invention

was made to provide the bill payment system of Chang et al. with payee companies employing internally networked stations with a company server accessible thru the Internet or Intranet and utilizing various deposit accounts, in order to allow more than one employee to perform the same activities and track incomes from different income streams.

8. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. in view of Examiner's Official Notice of electronic check endorsement.

Chang et al. discloses the claimed device but is silent regarding the timing of generating the directive. It is old and well known in the area of electronic check processing to allow payees to electronically endorse checks prior to depositing them into their associated checking accounts to provide the payee convenience and control over deposits into their accounts. In this situation the directive is made only after the check has been electronically endorsed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide electronic check endorsing with the system of Chang et al., in order to provide payees with convenience and control over their deposit accounts.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 7, 14, 26 and 27 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703)308-5183. The fax phone number for the organization where this application or processing is assigned is (703)305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

EG

March 6, 2003

  
RENA DYE  
PRIMARY EXAMINER

3/7/03

Tech Center 3600